

REMARKS

1. Rejection of Claims under 35 U.S.C. §112

Applicants note with thanks that the Examiner has found that the Amendment filed on May 5, 2006 overcomes the prior rejection of the claims under U.S.C. §112, second paragraph.

2. Rejection of Claims under 35 U.S.C. §103(a)

The Examiner has rejected all pending claims under 35 U.S.C. §103(a), over Shipley in view of Mink and Hamed, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The Examiner has concluded that the Applicants are urging that combining more than two transition metal catalyst components in the same catalyst composition to obtain a broad or bimodal molecular weight distribution polymer is unobvious. However, Applicants respectfully submit that this analysis over-simplifies the claimed invention by ignoring claim limitations and further combines three different references without any suggestion in the references which might lead those skilled in the art to combine catalyst components selected from the cited references.

The Examiner maintains that each of Shipley, Mink and Hamed combine two transition metal catalyst components in a catalyst composition for the purpose of obtaining a broad or bimodal molecular weight distribution polymer. Based on this, the Examiner concludes that it would be obvious to combine more than two such components to obtain the same effect and apparently that the various catalyst compounds and supports disclosed in the three cited references are interchangeable (since Applicants' claims are directed to the use of specific classes of catalyst compounds and not simply to any three transition metal compounds). The Examiner does not address Applicants' argument that catalyst compositions are notoriously

unpredictable, and that those skilled in the art would not assume that teachings regarding the activity of catalyst compounds in different catalyst systems are interchangeable.

Applicants submit that the Examiner has no support for the conclusion that catalyst components and supports disclosed in the catalyst compositions of Mink and Hamed can simply be substituted into the catalyst composition of Shipley with predictable effects. Further, the observation that it would be advantageous to use an organic support in a catalyst composition because polymers produced with such catalyst composition would have less ash upon combustion, does not provide a basis for concluding that an organic support will work in modified versions of the Shipley or Mink catalysts, especially when neither Shipley nor Mink suggested the use of organic supports.

As explained in MPEP §2143, to reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "**as a whole**" would have been obvious at that time to that person. Impermissible hindsight must be avoided and the legal conclusion of obviousness or unobviousness must be reached on the basis of the facts gleaned **from the prior art**.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Shipley omits a metallocene and an organic support from his catalyst. One cannot cure these deficiencies to find the presently claimed catalyst by incorporating the metallocene catalyst component from Mink, because Mink teaches the use of only two transition metal compounds (a metallocene and a Ziegler-Natta catalyst component) (See Mink, col. 1, lines 43-45) and further teaches the use of an inorganic support. Although Hamed teaches the use of a polymeric organic support, Hamed also uses a catalyst system with only two (2) transition metal compounds. In fact, none of Shipley, Mink or Hamed contain three (3) transition metal compounds, as is required by the presently pending claims. To combine these references as the Examiner has done, there must be some suggestion within the references to select specific catalyst components from three (3) different references.

Accordingly, since none of the cited references suggest the combination made by the Examiner, and the combination made by the Examiner ignores significant differences between the catalyst systems being combined, Applicants submit that the rejection of the pending claims under § 103 is improper and should be withdrawn.

In view of the foregoing, Applicants believe that claims 1, 4, 5, 7, 8, 10, 11, 14-19 and 21-26 are now in condition for allowance.

3. Request for Rejoinder of Process Claims

Process claims 27, 28 and 30 were withdrawn pursuant to a restriction requirement. The standard for rejoinder of non-elected process claims after the allowance of product claims is set forth in MPEP § 821.04. This section provides that where an applicant presents both product and “process of using the product” claims in an application and elects claims directed to the product in response to a restriction requirement, if the product claim are found to be allowable, the process claims which depended from allowed process claims will be rejoined. Since withdrawn

claims 27, 28 and 30 depend from claim 1, these process claims should be rejoined upon the allowance of claim 1.

No additional fees are believed due herewith. If any additional fees are due, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-0540.

Conclusion

In view of the foregoing, withdrawal of all rejections and the allowance of the pending claims is respectfully requested. Further, rejoinder of non-elected process claims 27, 28 and 30 is also requested.


If the Examiner believes that there are any further issues which present an impediment to allowance, it is respectfully requested that the undersigned be contacted to conduct a telephone interview.

If additional fees are due, the Commissioner is authorized to charge the same to Deposit Account No. 50-0540.

Respectfully submitted,

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